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66170 7590 09/28/2010 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER				
AHMED, AFFAF				
ART UNIT		PAPER NUMBER		
3622				
NOTIFICATION DATE		DELIVERY MODE		
09/28/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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### Office Action Summary

**Application No.**

10/091,612

**Applicant(s)**

TAGSETH ET AL.

**Examiner**

AFAF AHMED

**Art Unit**

3622

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 51-59, 61-65 and 67-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 51-59, 61-65 and 67-70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Status of Claims***

1. This action is in reply to the amendment filed on 08/06/2010.
2. Claims 51-53, 54-59, 61-65, 67-70 have been amended.
3. Claims 60 and 66 have been canceled.
4. Claims 51-59, 61-65 and 67-70 are currently pending and have been examined.

### ***Response to Applicant's Arguments***

5. Applicant's amendments and arguments filed on 08/06/2010 have been fully considered and discussed in the next section. Applicant is reminded that the claims must be given its broadest, reasonable interpretation.
6. With regard to claims 51, 66, 69 and 70 rejection under 35 USC § 112 first paragraph, Applicant has either amended and/or cancelled the claims. Therefore, the claim rejection under 35 USC § 112 first paragraph is withdrawn.
7. With regard to claims 51, 52, 58, 68 and 69 rejection under 35 USC § 112 second paragraph, Applicant has either amended and/or clarified the claims. Therefore, the claim rejection under 35 USC § 112 second paragraph is withdrawn.
8. With regard to claims 51-59 and 61-70 rejection under 35 USC §102 (e):
  - Applicant argues that *"Brody does not disclose a system that is able to customize the summary or contents of an offer."*

Examiner respectfully disagrees. Applicant is reminded that the claims must be given its broadest reasonable interpretation. Thus, Brody in at least paragraph 41 discloses a system, where an offer processing engine identifies and retrieves the identity of one or more consumers seeking a subcategory of loans via a user selectable graphic interface. The offer processing engine retrieves data from the data broker and caches that represents a consumer's credit data, and retrieves configuration data, such as the pre-approved offers (content and/ or summary of offers) a consumer is viewing. the offer processing engine stores preference information regarding merchants, such as placement of pre-approved offers made to consumers by merchants, along with the category the merchant's offer falls into so that a consumer can select the types of offer ( based on offer content and/ or summary of offer) the consumer wishes to receive.

- Applicant argues that *"Brody does not disclose an offer that is made up of a content component and a display component that may be customized based on the user seeking the offer."*

Examiner respectfully disagrees. Applicant is reminded that the claims must be given its broadest reasonable interpretation. As shown above, Brody in at least paragraph 41 discloses a system, where an e offer processing engine identifies and retrieves the identity of one or more consumers seeking a subcategory of loans via a user selectable graphic interface. The offer processing engine retrieves data from the data broker and caches that represents a consumer's credit data, and retrieves configuration data, such as the pre-approved offers (content and/ or summary of offers) a consumer is viewing. the offer processing engine stores preference information regarding merchants, such as placement of pre-approved offers made to consumers by merchants, along with the category the merchant's offer falls into so that a consumer can select the types of offer ( based on offer content and/ or summary of offer) the consumer wishes to receive.

Examiner respectfully disagrees. Furthermore, Brody also in at least paragraph 54 discloses a system that can be accessed via an internet web page, where information received from the consumer may be extensive and exhaustive so that the consumer can be accurately identified and offered customized service based upon one or more aspects of the consumer's profile. Brody in at least paragraph 14 discloses selecting a plurality of pre-approved offers for the consumer based at least partially on the credit history data of the consumer and a subject preference provided by the consumer.

9. With regard to claim rejection under 35 USC §103 (a):

- With regard to claim 60, Applicant has cancelled claim 60. Therefore, Applicant's arguments are moot.
- With regard to claims 51, 69 and 70, Applicant argues that *"the cited references, alone or in combination, do not disclose or contemplate at least identifying, by the computer based system, a plurality of incentive offer contents based on the user formulated search and the attributes of the user profile; identifying , by the computer based system, an incentive offer context based on the attributes of the user profile or combining, by the computer based system, each customized offer with the incentive offer context to create a plurality of user offers."*

Examiner respectfully disagrees. Applicant's assertion is false. Claims 51, 69 and 70 was not rejected under 35 USC §103 (a).

However, as mentioned above, Brody in at least paragraph 41 discloses an embodiment where an offer processing engine stores merchant offers and configuration information enabling the system to produce real time updates on merchant offers made to consumers via the system. The offer processing engine identifies and retrieves the identity of one or more consumers seeking a subcategory of loans via a user selectable graphic interface. Brody also disclose the offer processing engine can store preference information regarding merchants, such as placement of pre-approved offers made to consumers by merchants, along with the category the merchant's offer falls into so that a consumer can select the types of offer the consumer wishes to receive (paragraph 41). Brody also in at least paragraph 44 discloses an

embodiment where consumer preferences database maintains profiles on a consumer so that specific offers ads, or other information can be presented to a consumer upon that consumer's initial log-in to the system. Brody also in at least paragraph 54 discloses a system that can be accessed via an internet web page (offer context), where information received from the consumer may be extensive and exhaustive so that the consumer can be accurately identified and offered customized service based upon one or more aspects of the consumer's profile. Brody in at least paragraph 14 discloses selecting a plurality of pre-approved offers for the consumer based at least partially on the credit history data of the consumer and a subject preference provided by the consumer. Furthermore, Brody in at least paragraph 15 discloses a method includes receiving consumer data records from a plurality of databases, selecting for the consumer at least one pre-approved offer based on at least one consumer data record associated with the consumer, and sending a web-based representation of the pre-approved offer to the consumer.

### ***Claim Objections***

10. Claims 51 and 69 are objected to because of the following informalities: Claims 51 and 69 recite the limitation of: *modifying, by the computer based system at least of portion of the plurality of inventive offer contents based on the attributes of the user profile*. The term *inventive* appears to be a typographical error. For the purpose of this Examination, the Examiner interprets the term "*inventive*" to mean "*incentive*". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claim 51 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 51 and 69 recite the limitations of:
- *analyzing, by the computer-based system, attributes of a user profile*. It is unclear whether Applicant is referring to the same user that is formulated search in the receiving step of to a different user. Appropriate correction and/ or clarification is required.
- *filtering by the computer-based system, each summary of the plurality of incentive offer contents from a centralized repository of incentive offers contents, based on the user formulated search and the attributes of the user profile, wherein each summary corresponds to a customized offer for a user*. It

is unclear whether Applicant is referring to the same user that is formulated search in the receiving step of to a different user. Appropriate correction and/ or clarification is required.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claims 51-59, 61-64, 67-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brody, US Pub No: 2002/0077964 A1 in view of in view of Dedrick, US Pat No: 5,696,965.

#### **Claims 51, 69 and 70:**

Brody discloses:

- *receiving , by a computer-based system for customizing an incentive offers, a user formulated search (see at least paragraph 41);*
- *analyzing, by the computer-based system, attributes of a user profile (see at least paragraphs 34,38 and 44);*
- *identifying, by the computer-based system a, plurality of incentive offer contents based on the user formulated search and the attribute of the user profile (see at least paragraphs 14-15 and 41);*
- *identifying, by the computer –based system an incentive offer context based on the attributes of the user profile (see at least paragraph 54);*
- *filtering by the computer-based system, each summary of the plurality of incentive offer contents from a centralized repository of incentive offers contents, based on the user formulated search and the attributes of the user profile,*

*wherein each summary corresponds to a customized offer for a user (see at least paragraphs 14, 41, 54 and fig 2 with the associated text); and*

- *combining, by the computer-based system, each customized offer with the incentive offer context to create a plurality of user offers and displaying, by the computer-based system, the incentive offer to the user (see at least paragraphs 14, 54 and 75);*

Brody does not specifically disclose, but Dedrick however discloses:

- *modifying by the computer-based system, at least portion of the plurality of incentive offer contents based on the attributes of the user profile (see at least column 5, lines 1-13, column 8, lines 40-56 and fig 2 with the associated text);*

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Brody's teaching for providing consumers with offers from a selected group of merchants on a webpage with Dedrick's teaching of modifying (offers) based on user's information (offeree's traits) with the motivation of providing users personalized offers.

**Claim 52:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *maintaining, by the computer-based system, the plurality of incentive offer contents, wherein the plurality of incentive offer contents are at least one of created, modified, or deleted within the centralized repository in response to an administrator request (see at least paragraphs 44 and 47);*

**Claims 53 and 54:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *authenticating, by the computer-based system, the merchant in response to a request by the merchant to submit at incentive offer to the centralized repository;*
- *limiting access to the merchant to the centralized repository;*

See at least paragraphs 33 and 72;

**Claim 55:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *tracking, by the computer-based system, a number of times the incentive offer has been displayed to the user* (see at least paragraph 44);

**Claim 56:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *tracking, by the computer-based system, a number of times a class of the incentive offers has been displayed to the user* (see at least paragraphs 44 and 69-70);

**Claim 57:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *wherein the incentive offer is displayed via a webpage* (see at least paragraphs 55 and 69);

**Claims 58 and 59:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *generating, by the computer-based system, a report describing the incentive offers contained within the centralized repository;*
- *wherein the report describes a number of times the incentive offer has been retrieved;*

See at least paragraph 44 and fig 2 with the associated text;

**Claim 61:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer details include at least of an offer identifier, an offer promotion identifier, an offer type, or a definition of offer terms* (see at least paragraph 69);

**Claim 62:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further identifying at least one of a merchant name, a target merchant, a target good, or a target service* (see at least paragraphs 54 and 68);



**Claim 63:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further includes at least one of merchant demographic, merchant type, or geographic location identifier* (see at lest paragraphs 52 and 78);

**Claim 64:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further includes at least one of offer category identifier, a target product, or service identifier* (see at lest paragraph 68);

**Claim 65:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *wherein the offer further includes at least one of a description of terms of the offer, a term length for displaying the offer, a keyword, SKU/UPC information , or customer service telephone number* (see at least paragraph 41);

**Claim 67:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *wherein the centralized repository is maintained by an issuer of the user transaction account* (see at least paragraphs 41, 44 and fig 2 with the associated text);

**Claim 68:**

The combination of Brody/ Dedrick discloses the limitations as shown above.

Brody further teaches:

- *receiving, by the computer-based system, an acceptance of the incentive offer from the user* (see at least paragraphs 16 and 42);

***Conclusion***

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS from the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX Months from the mailing date of this final.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Affaf Ahmed whose telephone number is 571-270-1835. The examiner can normally be reached on Monday - Friday, 8:30 am-6:00 pm est, alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached at 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

09/17/2010

/Yehdega Retta/  
Primary Examiner, Art Unit 3622